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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,273	12/26/2000	Julie R. Korenberg	42778.8003.US02	4861
34055	7590	05/13/2004	EXAMINER	
PERKINS COIE LLP POST OFFICE BOX 1208 SEATTLE, WA 98111-1208			HORLICK, KENNETH R	
			ART UNIT	PAPER NUMBER
			1637	

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/749,273

Applicant(s)

KORENBERG ET AL.

Examiner

Kenneth R Horlick

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant's election without traverse of Group XII, claims 40 and 41, in the paper filed 03/08/04 is acknowledged. Claims 1-39 and 42-46 are cancelled.

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. It is submitted that the current method claims are not reflected in the current title.

3. Claims 40-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) These claims are confusing because of the language "contracting a sample" in line 4 of claim 40; apparently, "contacting" is intended. Correction is required.

B) These claims are further confusing because the language of the preamble of claim 40 is not in agreement with the recited single method step. The preamble recites a method "of diagnosing a predisposition to a disorder associated with the expression of a specific human EHOC-1 polypeptide allele", but the only recited step is one of "contacting a sample...with a plurality of probes...". Such a contacting step is not sufficient to define a diagnostic method. Clarification is required.

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4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 40 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

These claims are drawn to a method of diagnosing a predisposition to a disorder associated with the expression of a specific human EHOC-1 polypeptide allele, using a plurality of probes. However, the specification does not describe any such alleles, let alone probes capable of detecting them. The specification is limited to the description of the EHOC-1 nucleic acid of SEQ ID NO:1, and no alleles or mutations are described which are associated with a predisposition to any disease. Thus, applicants were clearly not in possession of the claimed methods at the time of filing the application.

6. Claims 40 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In Ex parte Forman, 230 USPQ 546 (Bd. App. 1986), the Board considered the issue of enablement in molecular biology. In considering these factors: (a) in order to practice the invention, the practitioner must be able to make and use probes capable of diagnosing a predisposition to a disorder associated with the expression of a specific human EHOC-1 polypeptide allele; (b) the specification provides no guidance as to any such specific alleles correlated with a disorder; (c) no working examples are presented as to any such specific alleles; (d) the invention is directed to diagnostic methods; (e) the prior art teaches some disorders which appear to be associated with the EHOC-1 locus; (f) the level of skill in molecular biology is high; (g) the results of experiments involving determination of alleles of a gene associated with a disorder is not predictable; (h) the claims are broadly drawn, reciting probes for detecting any possible alleles which are associated with any possible disorder. Based on the above analysis, one of ordinary skill in the art would be subject to undue experimentation in identifying and designing probes targeting EHOC-1 alleles associated with predisposition to a disorder, assuming such alleles even exist.

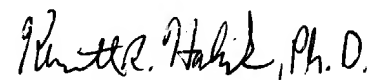
7. Claims 40 and 41 are free of the prior art, but are rejected for other reasons. No claims are allowable.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R Horlick whose telephone number is 571-272-0784. The examiner can normally be reached on Monday-Thursday 6:30AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kenneth R Horlick
Primary Examiner
Art Unit 1637

05/12/04